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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05725.1017-00000

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Signature _____

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name _____

Application Number

10/060,234

Filed

February 1, 2002

First Named Inventor

Jean-Louis H. GUERET

Art Unit

3751

Examiner

H. Le

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 54,047☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

F. Chad Copier

Typed or printed name

571-203-2747

Telephone number

12/8/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket No. 05725.1017



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jean-Louis H. GUERET

Application No.: 10/060,234

Filed: February 1, 2002

For: DEVICE FOR APPLYING A
PRODUCT

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)
) Group Art Unit: 3751
)
) Examiner: H. LE
)
) Confirmation No.: 8084
)
) **Mail Stop AF**
)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the Final Office Action mailed August 8, 2005, and pursuant to the July 12, 2005, OG Notice regarding the Pre-Appeal Brief Conference Pilot Program, Applicant respectfully requests panel review of the rejections discussed in the remarks below. No amendments are being filed with this Request. This Request is being filed concurrently with a Notice of Appeal and a petition for a one-month extension of time.

REMARKS

I. Status of the Claims

Claims 1, 3-9, 11-17, 22-51, 60-67, 70-83, 85-91, 96-108, 110, 112-116, 118-121, 123, 132, 133, 135-141, 144-156, 158-164, 169-182, 184-192, 194, 203, 204, and 206-212 remain pending in this application. Claims 1, 3-9, 11-17, 22-42, 45-51, 60-67, 70-76, 78-83, 85-91, 96-108, 110, 112-114, 118-121, 123, 132, 133, 135-141, 144-149, 151-156, 158-164, 169-182, 184-186, 189-192, 194, 203, 204, and 206-212 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 4,549,835 to Gray, and claims 3, 43, 44, 77, 115, 116, 150, 187, and 188 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of U.S. Patent No. 4,519,795 to Hitchcock, Jr. et al. ("Hitchcock").

II. Rejection of Claims under 35 U.S.C. § 102(b)

Applicant respectfully submits that claims 1, 3-9, 11-17, 22-42, 45-51, 60-67, 70-76, 78-83, 85-91, 96-108, 110, 112-114, 118-121, 123, 132, 133, 135-141, 144-149, 151-156, 158-164, 169-182, 184-186, 189-192, 194, 203, 204, and 206-212 are not anticipated by Gray for at least the reason that Gray fails to disclose each and every claimed element. For example, Gray fails to disclose "a first portion defining a recess; a second portion moveable with respect to the first portion... wherein the first portion and the second portion define a substantially closed reservoir when the device is in the closed position; and an application member attached to the second portion," as recited in claim 1.

Gray discloses a method for making sachets having a pocket (labeled 5 in Fig. 2) between two sheets of film or foil. The method includes placing a measured amount of liquid into a depression in one sheet of film or foil 4 and placing a carrier 10 into the depression. Col. 1, lines 63-66; col. 2, lines 56-58. A second film or foil 1 is then placed over the depression containing the liquid and carrier 10 and the second film 1 is sealed to the first film 4 around the edges in such a manner so as to compress the carrier 10 in the pocket 5. Col. 2, lines 2-7. The sachet is configured to be opened by tearing across both the first sheet and second sheet, facilitated by a V-notch 11 in the sachet. Col. 3, lines 22-23.

In the Office Action, the Examiner alleges that Gray "discloses a device comprising a first portion 4 defining a recess 5; a second portion 1 movable with respect to the first portion 4... and an application member 10 attached to the second portion." Office Action at 3. The Examiner's allegations are flawed for at least two reasons. First, Gray simply fails to disclose any attachment between carrier 10 and layer 1. The Office Action does not explain the Examiner's allegation that carrier 10 is "attached" to a portion of Gray's sachet. The Office Action simply fails to address the "attached" recitation with anything more than a conclusory statement. Such "broad conclusory statements standing alone are not 'evidence'." In re Kotzab, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). A careful reading of Gray reveals that the reference does not support the position alleged in the Office Action. At best, carrier 10 of Gray is in contact with, but not attached to, one or both layers of the sachet at various stages.

Second, Gray does not disclose the recited second portion “movable” with respect to the first portion. The sachet of Gray is configured to be opened by tearing both the first layer 4 and second layer 1 at notch 11, but Gray does not disclose whether layer 1 is moveable with respect to layer 4. Because Gray fails to disclose each and every element or limitation of the claimed invention, Applicant respectfully submits that the Gray reference fails to anticipate claims 1, 71 and 144, and all claims depending from those claims.

III. Rejection of Claims under 35 U.S.C. § 103(a)

Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 3, 77, and 150¹ under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of Hitchcock for at least for the reason that there would have been no motivation to one of ordinary skill in the art at the time the invention was made to modify Gray in view of Hitchcock. See MPEP. § 706.02(j).

In the Office Action, the Examiner correctly recognizes that Gray “does not disclose that the application member 10 [is attached] to the second portion 1 by bonding. Office Action at 4. In an effort to overcome this deficiency, the Examiner points to Hitchcock, as allegedly teaching “another application device having a pad attached to a plastic strip by an adhesive.” Office Action at 4. A careful comparison of Gray and Hitchcock reveals that one of ordinary skill in the art would not look to the attached pad of Hitchcock to overcome the deficiency of Gray because both layers 1, 4 of Gray are configured to be torn and destroyed upon opening the sachet. Additionally,

attaching carrier 10 to layer 1 of Gray, as suggested by the Examiner, would essentially destroy the usefulness of the Gray device because any attachment would make it impossible to remove carrier 10 from the opening in the sachet created by tearing the sachet at V-notch 11. Because there would have been no motivation to combine the features of Gray and Hitchcock, the Office Action fails to establish a *prima facie* case of obviousness.

IV. Conclusion

Because the Examiner's 35 U.S.C. § 102(b) rejection over Gray is based on factual deficiencies, and because the Examiner's 35 U.S.C. § 103(a) rejections over Gray and Hitchcock include errors, Applicant is entitled to a pre-appeal brief review of the Final Office Action. Moreover, all of the claim rejections should be withdrawn.

Please grant any extensions of time required to enter this Request and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 8, 2005

By: 

F. Chad Copier
Reg. No. 54,047

¹ The 35 U.S.C. § 103(a) rejections of claims 43, 44, 115, 116, 187 and 188 are not addressed in detail in this Request because of space limitations and because each of the claims is allowable at least due to their dependence on an allowable independent claim.